

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW SCOTT BURNES ET AL.

Appeal No. 2001-2292
Application No. 09/072,172

ON BRIEF

Before COHEN, STAAB and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Andrew Scott Burnes et al. appeal from the final rejection of claims 9, 14 through 16, 18 and 28. Claims 10 through 13, 17, 19 through 27 and 29 through 46, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

The subject matter on appeal relates to a feminine hygiene absorbent system particularly suited to accommodate the viscous nature of menses fluid. Representative claim 9 reads as follows:

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9. A personal care product system comprising a distribution/retention layer and a pad shaping layer wherein each layer has a stain length ratio of 0.5 or less and said distribution/retention layer has a saturation profile of 4 or less, a density between 0.1 and 0.2 g/cc and an average pore size diameter of about 40 to 500 microns.

THE REJECTIONS

Claim 9, and claims 14 through 16, 18 and 28 which depend therefrom, stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling specification.

Claims 9, 14 through 16, 18 and 28 also stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

Attention is directed to the appellants' brief (Paper No. 15) and to the examiner's answer (Paper No. 16) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection

Insofar as the enablement requirement of 35 U.S.C. § 112, first paragraph, is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application,

would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The examiner considers the appellants' disclosure to be non-enabling with respect to the subject matter set forth in the appealed claims because it

fails to provide an adequate written description of the invention so that one of skill in the art could make the invention so that it would provide the claimed test characteristic values as is claimed in claim 9. What specific materials in what kind of structural configuration will provide these test values for each layer? This is not clear. The specification also fails to adequately describe the actual test procedure for the claimed test characteristic values; consequently, one of skill in the art would not be able to perform the tests. How is the stain length ratio calculated? How much fluid is used and under what conditions do these tests occur? The tests procedures themselves are not enabled [examiner's answer, page 3].

A review of the appellants' disclosure, however, shows that the examiner's concerns are unfounded. More particularly, and with respect to the subject matter recited in claim 9, the appellants' specification expressly describes with a fair degree of detail (1) the manner in which the densities of the layers are calculated on page 11, (2) the manner in which the pore sizes of

the layers are determined on pages 15 and 16, (3) the testing equipment on page 12, (4) the test procedure on pages 12 and 13, (5) the menses stimulant used in the test procedure on pages 13 through 15, (5) examples of the composition and construction of the distribution/retention and pad shaping layers on, for example, pages 19, 20, 22 through 31, 40 and 41, (8) the insult rate of the menses stimulant during the test procedure on page 26, (9) the definition of the stain size (or length) ratio on page 28,¹ and (10) the definition of the saturation profile (ratio) and its manner of computation on pages 29 and 30.² Given these descriptions, it is not apparent, nor has the examiner cogently explained, why the appellants' disclosure would not have enabled a person of ordinary skill in the art to make and use the

¹ The appellants have used the terms "stain length ratio" (claim 9 and specification page 29) and "stain size ratio" (specification page 28) to describe the same parameter, i.e., "the width of the stain divided by the length of the stain after the stain has reached equilibrium" (specification page 28). In the event of further prosecution, steps should be taken to harmonize this terminology ("stain size ratio" would appear to be the more accurate term).

² Similar to the situation commented on in n.1, supra, the appellants have used the terms "saturation profile" (claim 9 and specification page 29) and "saturation profile ratio" (specification page 30) to define the same parameter. Here again, steps should be taken in the event of further prosecution to harmonize this terminology.

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invention recited in the appealed claims without undue experimentation.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, non-enablement rejection of claims 9, 14 through 16, 18 and 28.

II. The 35 U.S.C. § 112, second paragraph, rejection

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner considers claims 9, 14 through 16, 18 and 28 to be indefinite because

[t]he test characteristic values are considered indefinite because a person wishing to avoid infringement of claim 9 (if allowed) would not be able to determine whether or not they are infringing because the test procedure is not . . . sufficiently set forth in the specification. The scope of claim 9 is not

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clear because of the claimed test values [examiner's
answer, page 4].

For the reasons discussed above in connection with the 35
U.S.C. § 112, first paragraph, rejection, the examiner's position
here is unfounded.

Therefore, we shall not sustain the standing 35 U.S.C. §
112, second paragraph, rejection of claims 9, 14 through 16, 18
and 28.

SUMMARY

The decision of the examiner to reject claims 9, 14 through
16, 18 and 28 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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